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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,496	12/21/1999	RON WAKSMAN M. D.	WELD-111-DIV	3711
7590 03/09/2006				
STEPHEN B. HELLER COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER, LTD. 200 WEST ADAMS STREET - SUITE 2850 CHICAGO, IL 60606			EXAMINER DESANTO, MATTHEW F	
			ART UNIT 3763	PAPER NUMBER

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 09/468,496	Applicant(s) WAKSMAN M. D. ET AL.	
	Examiner Matthew F. DeSanto	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35, 37, 42-44 and 47-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-35, 37, 42-44 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

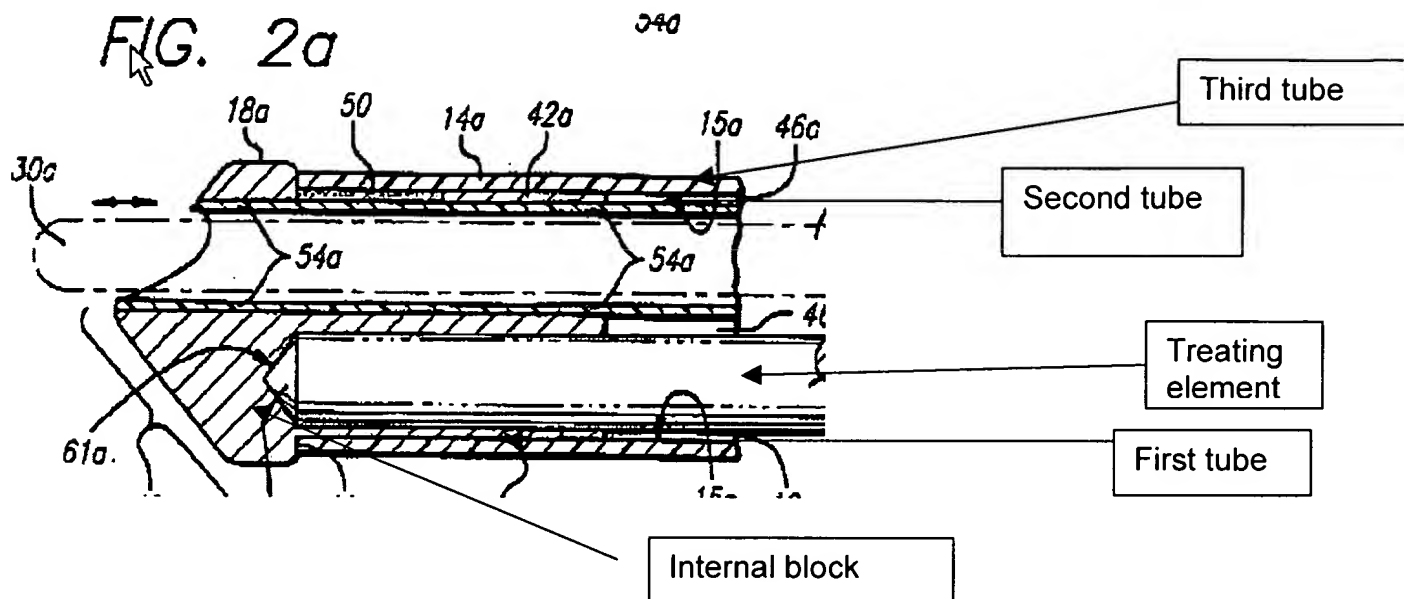
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29, 33, 43, 44, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Nita et al. (USPN 5,542,917).

Nita et al. discloses a catheter comprising, a first tube (42a) having a lumen closed at its distal end and sized to receive the treating element, a second tube (54a) in parallel relation to the first tube and having a lumen open at its distal end and sized to receive a guidewire, and a third tube (15a) for receiving first and second tube and having a fluid return lumen (46a) in fluid communication with the lumen of the first elongated tube.

The examiner interprets Nita et al. to have a treating element that is slidingly received in the first lumen, because the treating element is an ultrasonic device, thereby vibrating or shaking in all directions, which in turns would make the treating element slidingly received in the lumen, since the treating element would be vibrating from the proximal to the distal direction. (Figure 2a, and Column 4, lines 10-50, Column 6, lines 25-30).



Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 30, 31, 32, 35, 37, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nita et al. (USPN 5,542,917).

5. Nita et al. discloses the claimed invention except for particular structure of the catheter. Nita et al. fails to disclose the distal end of the third tube extending beyond the first and second tube; a third tube that is flexible, which tapers; a distal end of the second tube which is coterminous with the distal end of the third tube, both of which extend beyond the distal end of the first tube; a first lumen that has an inside diameter less than twice the outside diameter of the treating element; and wherein the tubes are

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substantially the length of the catheter. Therefore, at the time of the invention it would have been an obvious matter of design choice to one skilled in the art to modify the apparatus as taught by Nita et al. to have any different catheter structure as stated above, since the applicant has not disclosed that the above structure provides any criticality and/or unexpected results and it appears that the invention would perform equally well with any catheter structure, such as the structure taught by Nita et al. since the catheter will be used inside the body to treat a patient and has a flexible distal tip that could be formed as the third tube, which would allow Nita et al. to read on the limitations of the claimed invention.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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7. Claims 29, 32, 33, 34, 35, 37, 43, 44, 47, 48, 49 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,683,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 29, 44, 48 of the application is similar to claim 1 of the '345 patent, and wherein claim 32 of the application is similar to claims 5 in view of claim 1, of the '345 patent, and wherein claims 33, 34, 43, 47 of the application is similar to claim 3 in view of claim 2 and claim 1 of the patent '345, and wherein claim 35, 37 of the application is similar to claim 4 of the patent '345

8. The double patenting rejection is made because of the difference between the claims of the application and claims of the patent lie in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of the claims of the patent is in effect a "species" of the "generic" invention claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Allowable Subject Matter

9. Claims 48 and 49 are in conditions for allowance over the prior art, but must still overcome the double-patented rejection.

10. Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments, with respect to Saab (US Pub 2005/0113893) have been fully considered and are persuasive. The rejections in view of Saab (US Pub 2005/0113893) have withdrawn as well as the double patenting rejection based on copending applications.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F. DeSanto whose telephone number is 571-272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Matthew DeSanto
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March 6, 2006